

REMARKS

Claims 1-11, 21-27 and 29-36 are pending in this application. By this Amendment, claim 21 is amended (to include features of claim 28) and claims 12-20 and 28 are canceled without prejudice or disclaimer to the subject matter set forth therein. No new matter is added by this Amendment.

Reconsideration and allowance in view of the following remarks are respectfully requested.¹

A. The Rejection under 35 U.S.C. 103

In the Office Action, claims 1-7, 9,11-15,17-26, and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,343,271 to Peterson et al. in view of U.S. Patent Application Publication 2003/0167220 to Schoen et al. Applicant respectfully traverses this rejection.

As set forth in M.P.E.P 706.02(j), 35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. M.P.E.P 706.02(j) indicates that after indicating that the rejection is under 35 U.S.C. 103, the Examiner should set forth in the Office Action:

(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,

(B) the difference or differences in the claim over the applied reference(s),

¹ As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., assertions regarding dependent claims, assertions regarding official notice, whether a reference constitutes prior art, whether references are legally combinable for obviousness purposes) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

(C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and

(D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

M.P.E.P 706.02(j) references the well known requirements of Graham v. John Deere. Further, M.P.E.P 706.02(j) notes that it is important for an Examiner to properly communicate the basis for a rejection so that the issues can be identified early and the Applicant can be given fair opportunity to reply.

In the Office Action, on page 2, regarding claim 1, the Office Action asserts various alleged teachings of Peterson. Thereafter, the Office Action reflects that Peterson fails to teach features of the claimed invention. Specifically, the Office Action asserts that Peterson et al. **fails to specifically point out**:

the benefits calculation engine comprising a plurality of formulas, each formula corresponding to specific disablement information, wherein the benefits calculation engine calculates benefits for multiple reimbursement products available for multiple disablement scenarios.

Thereafter, the Office Action attempts to cure such deficiencies with the teachings of Schoen. Specifically, the Office Action asserts:

However, Schoen et al. teaches a system "to enable disability issuing insurance carriers to perform data processing, calculation of coverage and or benefits, premium, and/or other consideration, record keeping and other requisite functions attendant to offering and administering group or individual disability insurance" (see: Schoen et al., paragraph 39); furthermore, it is possible to "set up multiple plans based upon different participation criteria" and the "system must be capable to tracking each plan separately yet combine them for various purposes" (see: Schoen et al., paragraph 258). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Peterson et al. and Schoen et al. with the rationale of providing the proper financial means to implement an insurance policy and to allow "insurers ... to customize reports based upon different combinations of plans" (see: Schoen et al., paragraph 258).

However, the Office Action has clearly identified a deficiency of Peterson, i.e., that Peterson fails to specifically point out (i.e., fails to teach), the benefits calculation engine comprising a plurality of formulas, each formula corresponding to specific disablement information. While the Office Action then proposes to modify Peterson with teachings of Schoen, the Office Action indeed fails to cure this acknowledged deficiency of Peterson.

In other words, even if it were obvious to modify Peterson with Schoen as alleged in the Office Action, which Applicant does not admit, such would still fail to cure the deficiencies of Peterson acknowledged in the Office Action. Thus, the 35 U.S.C. 103 rejection is deficient.

Relatedly, regarding claim 28 (features of which are now incorporated into claim 21), Applicant notes the Office Action on pages 12-13, paragraph 26. Therein, the Office Action asserts:

As per claim 28, Peterson et al. teaches the invention substantially as claimed, see discussion of claim 21, and further teaches:

-- the step of accessing a **benefit code** in order to select an appropriate **reimbursement formula** (see: column 2, lines 30-56).

Applicant acknowledges that Peterson does talk to the use of codes. However, Applicant submits that such portion of Peterson does not describe “the step of accessing a benefit code in order to select an appropriate reimbursement formula” as alleged in the Office Action. Indeed, it appears that Peterson, therein, fails to set forth teachings of a reimbursement formula, much less the particulars of the benefit code vis-à-vis the reimbursement formula, as claimed. Clarification of how Peterson describes such claimed feature is requested.

Even more so, as to the deficiencies of the rejection, such relied upon teaching (Peterson column 2, lines 30-56) is set forth in the “Background of the Invention” of Peterson’s disclosure. The Office Action utilizes such teaching in conjunction with the “Invention” of Peterson (i.e., as set forth in Peterson’s Summary of the Invention, and Detailed Description). However, the Background of the Invention of Peterson and the Invention of Peterson are distinct and separate. Thus, in order to combine the Background of the Invention with the Invention, a 35 U.S.C. 103 analysis as set forth above, is required, i.e., a Graham v. John Deere analysis is required. However, the Office Action sets forth no such analysis, but rather treats the Background of the Invention and the Invention of Peterson as one, which it is not. Accordingly, the rejection is deficient in that the analysis is inappropriate.

Applicant submits that claim 1 defines patentable subject matter at least for the reasons set forth above. Further, independent claims 21 and 30 recite patentable subject matter for reasons similar to those set forth above.

Applicant submits that the various dependent claims recite patentable subject matter for at least their various dependencies on the independent claims, as well as for the additional features such dependent claims recite.

Withdrawal of the 35 U.S.C. 103 rejection is requested.

B. The Further 35 U.S.C. 103 Rejection

In the Office Action, claims 8, 10, 16, 27, and 30-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,343,271 to Peterson et al. in view of U.S. Patent Application Publication 2003/0167220 to Schoen et al. and further in view of Official Notice. Applicant respectfully traverses this rejection.

Applicant submits that the further modification of Peterson based on the teachings of Schoen, and the asserted official notice, fails to cure the deficiencies of the rejection, as discussed above. That is, Applicant submits that even if it were obvious to modify Peterson based on the teachings of Schoen and the Official Notice, as asserted in the Office Action, which is not admitted by Applicant, such combination of applied art would still fail to fairly teach or suggest the claimed invention.

Further, Applicant submits that such dependent claims recite patentable subject matter for at least reasons similar to those set forth above, as well as the additional features such dependent claims recite.

The Office Action relies upon “Official Notice.” Applicant submits that it is never appropriate to rely solely on “common knowledge” in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 (“[T]he Board cannot simply reach conclusions based on its own understanding or experience—or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”); MPEP 2144.03 (Emphasis added).

The MPEP further recites that:

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these **circumstances should be rare** when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy

dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

MPEP 2144.03A. (Emphasis added). The summary of this section further recites that:

Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied. Furthermore, as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and serve only to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. See *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697; *Ahlert*, 424 F.2d at 1092, 165 USPQ 421.<

MPEP 2144.03.

Applicant hereby makes no admission as to the propriety of the various assertions of Official Notice, as set forth in the Office Action, and reserves such right. Rather, Applicant submits that the claims are allowable for the reasons as set forth above.

Withdrawal of the 35 U.S.C. 103 rejection is requested.

C. Conclusion

For at least the reasons outlined above, Applicant respectfully asserts that the application is in condition for allowance. Favorable reconsideration and allowance of the claims are respectfully solicited.

For any fees due in connection with filing this Response the Commissioner is hereby authorized to charge the undersigned's Deposit Account No. 50-0206.

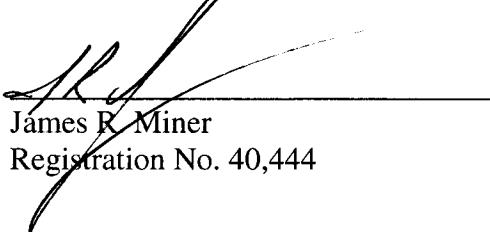
Should the Examiner believe anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

HUNTON & WILLIAMS LLP

Dated: 10/2/08

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